

REMARKS

Claims 1-24, 30 and 31 are pending. By this Amendment, no claims are cancelled, amended, or added.

Claim Objections

In the Office Action of July 12, 2010, the Examiner expressed certain objections to the claims as currently pending. Applicant responds as follows:

- Claims 1-10 were objected to as not being included in the listing of pending claims in the previous amendment. Applicant respectfully submits that under proper reissue practice, only the claims “being changed by [the current] amendment paper,” and each claim “being added by such amendment paper” should listed in full text form in any given amendment paper. 37 C.F.R. § 1.173(b)(2). Original claims 1-10 were last amended in the Preliminary Amendment of November 25, 2003, and since these claims are original, there is no need to present them under the applicable rule set forth above unless and until there are further amendments made to them. Accordingly, Applicant respectfully submits that it was proper for Applicant to exclude these claims from presentation in the previous amendment paper. Nevertheless, in the interest of advancing, and concluding, prosecution at this late date, Applicant has included in this amendment paper, claims 1-10 in the presently allowed form. Applicant respectfully submits that, although no statute, rule, or Office policy requires such, any formal need for presentation of these claims in the currently allowed form is obviated by the re-presentation of these claims in this

amendment paper. Applicant therefore respectfully requests that this objection be withdrawn.

- An objection was lodged to Applicant's amendment of October 9, 2007, in which certain amendments to the specification and drawings proposed in Applicant's Preliminary Amendment of November 25, 2003, were withdrawn by instruction. It is now asserted by the Office, nearly three years after Applicant's instruction to withdraw the subject amendments, that this instruction was somehow defective under the reissue statutes and rules. Applicant respectfully traverses this objection, and requests that the Office reconsider and withdrawn this objection.

It is unclear how Applicant can comply with the Examiner's wishes to have the "unamended form" of the proposed amended sections resubmitted, while still complying with proper reissue practice. All amendments in a reissue application are made relative to the original patent, not relative to previous amendments as in customary U.S. prosecution practice. See MPEP 1453(IV). Cancellation of previously proposed amendments entered in a previous action is accomplished by instruction only, without representation of the text of the cancelled matter. See MPEP 1453(V).

In this case, Applicant proposed certain amendments to the specification paragraph beginning at column 3, line 42, and certain amendments to the Abstract. See Preliminary Amendment of November 25, 2003, pp. 22-26. These amendments were represented in full in the Amendment of October 9, 2007, according to proper reissue practice. The amendment of October 9, 2007, however, also instructed that the new specification sections proposed for insertion after the heading "DETAILS OF

INVENTION” in the previous reissue amendments were to be withdrawn. This amounts to an instruction to cancel these newly proposed sections. It would be improper to show these new sections, which were proposed for addition in this reissue, in brackets or otherwise, since they are not included in the original patent.

Similarly, Applicant’s Preliminary Amendment of November 25, 2003, instructed the deletion of the specification passages beginning at column 4, line 14 and extending through column 4, line 34; the specification passages beginning at column 4, line 35 and extending through column 4, line 49; and the specification passages beginning at column 4, line 50 and extending through column 4, line 67. Preliminary Amendment, November 25, 2003, pp. 4-5. These deletions, however, were never clearly entered (or rejected) by the Examiner on the record, and in any case were rescinded by instruction in the amendment of October 9, 2007. See Amendment of October 9, 2007, p. 2. Since these passages of the specification will now remain as they are contained in the original patent, it is unclear how Applicant could show any “amendment” to these passages relative to the original patent, while remaining consistent with proper reissue amendment practice.

Further, the drawing amendments previously proposed by Applicant in the Preliminary Amendment of November 25, 2003, were simply intended to conform the drawings with the proposed amendments to the specification. ALL proposed drawing amendments were withdrawn by instruction in the Amendment of October 9, 2007. See Amendment of October 9, 2007, p. 12. There are simply NO “amendments” to the original drawings to show, after withdrawal of the proposed amendments. The drawings of the original patent remain as is.

In short, the “amendments” requested by the reissue Examiner cannot be shown consistent with proper reissue amendment practice. Accordingly, Applicant requests that this objection be withdrawn.

- The Amendment filed on November 25, 2008, was objected to as not being in the form required by 37 CFR 1.173(b). In particular, certain specification amendments were proposed having proposed deletions indicated by strikethrough instead of enclosed within brackets. In response, Applicant has re-proposed the subject specification amendments in this amendment paper, using the proper markings. Applicant respectfully requests that this objection be withdrawn.

Rejection Under 35 USC 251 For Recaptured Subject Matter

Claims 11-24, 30 and 31 stand rejected under 35 USC 251 for allegedly attempting to recapture subject matter surrendered during original prosecution. Applicant traverses this rejection on the grounds that the subject matter the Examiner alleges to have been “surrendered” was not in fact surrendered.

A proper recapture analysis includes three steps:

- (1) determine whether, and in what respect, the reissue claims are broader in scope than the original patent claims;
- (2) determine whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution; and
- (3) determine whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule.

MPEP 1412.02(I) (citing North American Container Inc. v. Plastipak Packaging, Inc., 415 F.3d 1335, 1349 (Fed. Cir. 2005)). The second step of the North American Container test involves two sub-steps: (A) determining whether an amendment made by the Applicant surrendered any subject matter; and (B) if so, determining whether the broadening of the reissue claims is in the area of the surrendered subject matter. MPEP 1412.02(I)(B)(1).

In determining whether “surrender” of subject matter has occurred, the proper inquiry is whether an objective observer viewing the prosecution history would conclude that the purpose of the patentee's amendment or argument was to overcome prior art and secure the patent. Kim v. Conagra Foods, Inc., 465 F.3d 1312, 1323 (Fed. Cir. 2006). Deliberately canceling or amending a claim in an effort to overcome a reference strongly suggests that the applicant admits that the scope of the claim before the cancellation or amendment is unpatentable, **but it is not dispositive because other evidence in the prosecution history may indicate the contrary.** In re Clement, 131 F.3d 1464, 1469 (Fed. Cir. 1997) [emphasis added]. While an inference of surrender may be drawn in some cases merely from changes in claim scope alone, such an inference is appropriate only when other reliable evidence of the patentee's intent is not available. See Ball v. U.S., 729 F.2d 1429, 1436 (Fed. Cir. 1984).

Here, the Examiner appears to find that merely because the originally filed claims were canceled after being rejected and new claims were substituted that, among many other things, include limitations drawn to “drive means” and “operator means,” there was necessarily a surrender of subject matter around the “drive means” and “operator means” elements. In reaching this conclusion, however, the Examiner ignores the evidence in the prosecution history

that these limitations were not added by Applicant to distinguish over the applied prior art and thus cannot have been surrendered.

As an initial matter, it is important to note that the claims as originally filed were written by a pro-se applicant and were not in the customary format used in U.S. patent practice. Instead, most of the original claims were composed of several sentence fragments, each ending with a period. Indeed, there were multiple rejections made for indefiniteness under 35 USC 112, Second Paragraph. Applicant submits that due to the very indefinite scope of these claims, it is simply not possible to determine with any degree of accuracy what was initially claimed. Hence, these claims can form no basis for any surrender analysis.

Even more importantly, the applicants never argued that the “drive means” and “operator means” elements of the claims added after cancellation of the original claims were distinguishing over the Linder reference used to reject the claims. While arguments were presented relative to certain claim elements, and how those elements distinguished over Linder, the “drive means” and “operator means” elements were not among those elements, and in fact, the “drive means” and “operator means” elements are not referenced at all in the Remarks section of the subject amendment. Moreover, in the Notice of Allowance issued in response to that amendment, the Examiner never made any indication on the record as to any reasons for subsequent allowance of the claims. There is quite simply no “clear and unmistakable” argument made by applicants in original prosecution that the invention does not cover any certain subject matter related to the “drive means” and “operator means” elements as required by law in order to find that subject matter was surrendered relative to these elements. MBO Laboratories, Inc. v. Becton, Dickinson & Co., 602 F.3d 1306, 1314 (Fed. Cir. 2010).

Consequently, there was no surrender of subject matter as contended by the Examiner. As a result, Applicant respectfully requests that this rejection be withdrawn.

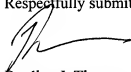
Reissue Declaration

The Examiner asserts that a “supplemental reissue oath/declaration” must be received before allowance of this application. Applicant traverses this rejection and respectfully submits the rejection is improper and must be withdrawn. Apart from deletions, which surely do not require a new declaration or oath by the inventors, there have been no substantive amendments made to the subject application after the last full reissue declaration signed by the inventors and submitted on November 25, 2008. Accordingly, Applicant respectfully submits that there is no legal requirement for a new reissue oath or declaration and Applicant respectfully declines to submit such at this time.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'B. J. Thorson', written over the printed name.

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